

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA and DWIP N. BANERJEE

Appeal 2007-0241
Application 09/931,296
Technology Center 2100

Decided: June 12, 2007

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-4, 6-11, and 13-28. Claims 5 and 12 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to a method and system for creating a software facility that provides a repository for various versions of software developed over a period of time. Each software version is stored in executable form enabling the separate execution of any program stored in the database. (Specification 6).

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. A system for maintaining, accessing and executing legacy computer software programs stored in a central location comprising:

a database for storing software programs, developed over a period of time, each software program being stored as a separate and independent software program;

a computing device connected to said database capable of interacting with said database for the purpose of retrieving and executing software programs stored in said database;

a interface device connected to computing device for interacting with said computing device; and

a computing network for connecting said interface device and said computing device.

The Examiner relies on the following prior art reference to show unpatentability:

Bentley	US 6,341,291 B1	Jan. 22, 2002
		(filed Apr. 22, 1999)

Claims 1-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bentley.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details.

ISSUES

Under 35 U.S.C § 102(e), does Bentley have a disclosure which anticipates the invention set forth in claims 1-28?

PRINCIPLES OF LAW

ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless

of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

ANALYSIS

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 10, 16, 22, and 28 based on the teachings of Bentley, the Examiner indicates (Answer 4-5) how the various limitations are read on the disclosure of Bentley. In particular, the Examiner directs attention to the illustration in Figure 10 of Bentley, as well as the disclosure at column 2, lines 20-29, column 15, lines 10-15, and column 17, lines 35-45 of Bentley.

In our view, the Examiner’s analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner’s prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Bentley so as to establish a prima facie case of anticipation. Appellants’ arguments (Br. 6-7; Reply Br. 3-4) focus on the contention that, in contrast to the language of the appealed independent claims which set forth that software programs are stored in a database, Bentley is storing engineering models in a database.

As Appellants' own remarks (Reply Br. 3:14-18) recognize, however, the engineering models of Bentley are comprised of a plurality of components, each of which includes a program for interpreting and modifying the component data values. (Bentley, col. 2, ll. 20-29, col. 4, ll. 52-65, and col. 17, ll. 16-41). While Appellants' arguments (Br. 7-8) attempt to distinguish the programs stored by Bentley from those claimed, it is our view that those arguments are not commensurate with the scope of the claims. We find no language in the appealed claims which requires that the claimed stored programs be externally accessible to execute particular tasks as asserted by Appellants. Conversely, we would add, there is nothing in the language of the appealed claims which precludes the stored programs from being interpretive programs which operate internally to modify the database components, such as those characterized as such by Appellants in Bentley. It is our opinion that Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

We further find to be without merit Appellants' related contention (Br. 8; Reply Br. 2) that any programs that might be stored in the database of Bentley are not "legacy programs" as described in Appellants' disclosure. We find it noteworthy that Appellants' arguments in the Briefs have pointed to no precise definition of the terminology "legacy programs" in their disclosure. Our review of Appellants' specification reveals that the wording "legacy programs" is discussed in the context of programs "that have been developed throughout history" (Specification 1:8 and 5:9) and of a software facility "that contains a chronology of the development of software over

time” (Specification 6:4). This latter terminology is used in the appealed claims to define the claimed stored software programs as those which have been “developed over a period of time.”

With the above discussion in mind, we simply find no error in the Examiner’s finding that the archived versions 45 of components 10 stored in the history chapters illustrated in Figure 14 of Bentley correspond to the claimed storing of software programs “developed over a period of time.” As described by Bentley, “[t]hese archived versions 45 represent the history of all changes made to the component 10.” (Bentley, col. 17, ll. 21-23). Bentley further describes (col. 17, ll. 36-37) the ProjectBank History file 3 as one that “holds a chronological list of the changes to the ProjectBank 2 in the form of chapters.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Bentley, the Examiner’s 35 U.S.C. § 102(e) rejection of independent claims 1, 10, 16, 22, and 28, as well as dependent claims 6-9, 11, 14, 17-21, and 23-27 not separately argued by Appellants, is sustained.

Turning to a consideration of the Examiner’s 35 U.S.C. § 102(e) rejection of dependent claims 2-4, 13, and 15, based on Bentley, we sustain this rejection as well. We find no error in the Examiner’s finding (Answer 5) of correspondence between the features described by Bentley and those set forth in appealed claims 2-4, 13, and 15. Our review of Appellants’ arguments (Br. 8; Reply Br. 3-4) reveals that Appellants have simply reiterated the features recited in claims 2-4, 13, and 15 and drawn a conclusion, without more, that the features in Bentley identified by the Examiner do not correspond to such claimed features. Such arguments do

not, in our view, satisfy Appellants' burden of providing evidence and/or arguments which show how the Examiner has erred in presenting a prima facie case of anticipation.

CONCLUSION

In summary, we have sustained the Examiner's rejections of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-4, 6-11, and 13-28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

pgc

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